

REMARKS

Claims 1-30 are all the claims presently pending in the application. Claims 20-30 have been withdrawn from consideration. Claims 1, 4, 5, 9 19-21, 23, 25, 26 and 28 have been merely editorially amended and have not been substantively amended to more particularly define the invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-19 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 1-19 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

These rejections are respectfully traversed in the following discussion.

I. THE 35 USC §112, FIRST PARAGRAPH REJECTION

The Examiner alleges that claimed invention of claims 1-19 was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and use the invention. The Examiner, however, is clearly incorrect.

Applicants submit that the test for enablement is “whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention”. More specifically, the claimed invention must be enabled “so that any person skilled

in the art can make and use the invention without undue experimentation” (see M.P.E.P. § 2164.01; emphasis added by Applicants).

Applicants point out, as set forth in the M.P.E.P., that the test for enablement is not whether any experimentation is necessary, or whether the experimentation is complex, but whether the experimentation is undue (see M.P.E.P. § 2164.01).

Furthermore, Applicants point out that “[a]s long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied” (see M.P.E.P. § 2164.01 (b); emphasis added by Applicants).

Applicants submit that the above standard for the enablement requirement has been met.

The Examiner’s allegations center on the flawed reasoning that the specification allegedly does not include a detailed description of the synthesis of the light-sensitive molecules and allegedly does not include working examples of the light-sensitive molecules. The Examiner’s application of the enablement requirement standard, however, is incorrect.

Applicants point out that the claimed invention is directed to a molecule manipulator, not the light-sensitive compound. Therefore, the specification must merely disclose at least one method for making and using the molecule manipulator that bears a reasonable correlation to the scope of the claimed molecule manipulator.

Applicants submit that the specification (e.g., see specification at Figure 3 and page 14, lines 6-16) discloses at least one method for making and using the molecule manipulator that bears a reasonable correlation to the scope of the claimed molecule manipulator.

Additionally, the Examiner surprisingly alleges that the level of experimentation is undue. Applicants submit, however, that the level of experimentation required to make and use the claimed invention is not undue. Applicants submit that the synthesis of azo compounds is a commonly known practice. That is, those skilled in the art understand that azo compounds can be synthesized by using an azocoupling reaction (i.e., an electrophilic substitution reaction on aromatic rings with diazonium salts). Applicants are not required to include a detailed explanation of this known process in accordance with the M.P.E.P. guidelines that a “patent need not teach, and preferably omits, what is well known in the art” (see M.P.E.P. § 2164.01).

Moreover, the Examiner surprisingly alleges that Applicants have failed to provide proper working examples. Applicants point out, however, that “[c]ompliance with the enablement requirement of 35 U.S.C. 112, first paragraph, does not turn on whether an example is disclosed. An example may be ‘working’ or ‘prophetic’. A prophetic example describes an embodiment of the invention based on predicted results rather than work actually conducted or results actually achieved. An applicant need not have actually reduced the invention to practice prior to filing” (see M.P.E.P. § 2164.02; emphasis add by Applicants). Therefore, Applicants submit that the examples provided in Figures 1 and 2 of the Application are sufficient for purposes of providing an enabling disclosure of the claimed invention.

II. THE 35 USC §112, SECOND PARAGRAPH REJECTION

The Examiner alleges that the claimed invention of claims 1-19 is indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the claimed invention. The Examiner, however, is clearly incorrect.

The Examiner, with respect to claims 1 and 2, alleges that the term “probe” is indefinite. Applicants submit, however, that when considering whether a term is indefinite the Examiner must consider the claim language in view of the teachings of the specification. The term probe is clearly defined in the specification at page 11, lines 4-18).

With respect to claim 3, Applicants point out that claim 3 depends from claim 1, not claim 2. Therefore, the materials recited in claim 1 do not refer to the features recited in claim 2.

With respect to claims 4 and 9, Applicants have amended the claims to replace the term “molecule” with the term “compound”.

With respect to claim 5, Applicants again point out when considering whether a term is indefinite the Examiner must consider the claim language in view of the teachings of the specification. This feature is clearly illustrated in Figures 1 and 2 of the Application.

With respect to claim 6, the language of the claim clearly defines that the bond of the second arm includes any bond other than an azo double bond.

With respect to claims 10, 12, 14, 16 and 19, Applicants submit that the claims have been amended as suggested by the Examiner.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

Applicants point out that in accordance with the Examination Guidelines set forth in the M.P.E.P., a patent application should not be examined in a “piecemeal”

manner. That is, the patent application must be evaluated under 35 U.S.C. §§101, 112, 102 and 103 at the same time.

Therefore, since the Examiner has not included any prior art rejections, Applicants have assumed that, in accordance with M.P.E.P. Examination Guidelines, the Examiner has conducted a thorough search of the existing related art and has not found any related art references that teach or suggest the claimed invention.

Therefore, if Applicants overcome the current rejections under 35 U.S.C. §112, first and second paragraphs, Applicants assume that the Application will be in condition for allowance.

In response to Examiner's objections to the specification, Applicants request the Examiner to refer to the arguments provide above in Section I.

In view of the foregoing, Applicant submits that claims 1-30, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

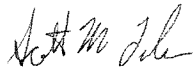
Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Serial No.: 10/642,615
Docket No. YOR920030023US1

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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